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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,655	01/15/2004	Jeffrey O. Meredith	8443-PA01	5890

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EXAMINER

DAVIS, CASSANDRA HOPE

ART UNIT PAPER NUMBER

3611

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,655

Applicant(s)

MEREDITH, JEFFREY O.

Examiner

Cassandra Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-16 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-8, 10, 11 and 19 is/are allowed.
- 6) ☒ Claim(s) 2-5, 9, 12-16 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 9, 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cockerham et al.

2. Cockerham teaches a magnetic arm ornament for the door of a motor vehicle comprising a planar member having a predetermined periphery with a shape that simulates at least a part of a human arm including an upper arm portion, an elbow portion, a lower arm portion, and a hand portion simulating at least part of a hand. (See figures 1 and 2). The upper arm portion having a straight upper edge forming part of the periphery of the member. (See figures 1 and 2). The title of the invention indicates that the ornament is magnetic. The ornament taught by Cockerham is adapted to have the straight upper edge of the upper arm portion of the ornament abuts the lower straight edge of a window of the vehicle door, whereby the appearance of the ornament can mimics that of a person in the vehicle hanging their arm out of the open window.

With respect to claims 9, 10, and 11, Cockerham clearly teaches indicia representing a human forearm. Cockerham does not teach the specific claimed indicia such as the shadow region, the sleeve and wrist band. However, it would have been obvious to one having ordinary skill in the art at the time this invention was made to provide whatever indicia desired by the user (whether it be shading type indicia to give a three or two dimensional effect), since it would only

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depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In re Gulack 217 USPQ 401, (CAFC 1983). Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

With respect to claim 2, the ornament taught by Cockerham is a flat, planar member.
(See figures 3-6).

With respect to claim 12, Cockerham does not teach the hand portion of the member having an upper straight edge part. It would have been obvious to one having ordinary skill in the art at the time this invention was made to cut or form the sign with any necessary cutouts or cuts to so that the sign conforms to the support surface to which it is mounted to so that the sign will not cover or overlap existing structure on the support surface.

With respect to claims 13-14, Cockerham teaches the shape of the periphery of the ornament simulates a bent arm with a bent elbow region between the upper and lower arm portions. Cockerham also teaches the hand portion represents a complete hand.

With respect to claim 15, since the applicant does not disclose that the indent of the sleeve portion of the sign solves any stated problem or if for any particular purpose, it appears that constructing the shape of the forearm of any suitable shape to show either a clothed forearm or naked forearm to enhance the indicia thereon would perform equally well.

With respect to claim 16, the front surface of the ornament taught by Cockerham has indicia show the contour of the muscles of the arm which give a three-dimensional appearance of a forearm.

3. Claims 3-5 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cockerham et al. in view of Baskerville, U. S. Patent Applicant Publication 2004/0148830A1.

With respect to claim 4, Baskerville teaches a magnetic vehicle sign comprising sign board 10 made of a flexible sheet of rubber material impregnated with ferromagnetic particulate which adhere the signboard 10 to the metal body of vehicle by magnetic attraction. (See paragraph [0022]).

Although neither Cockerham or Baskerville teaches the ornament/sign being die cut, since the applicant does not disclose that die cutting solves any stated problem or is for any particular purpose, it appears that cutting or forming the shape of the sign using any suitable means would perform equally well.

In addition, die cutting is method limitation, which is not given patentable weight is an article claim.

It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the magnetic ornament taught by Cockerham made of a flexible rubber magnetized sheet as taught by Baskerville to provide a light weight material and a material which can be rolled or otherwise deformed when not in use.

Claims 3, 4, 5, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cockerham et al. in view of Buhler, U. S. Patent 6,041,534.

Buhler teaches flexible magnetic panel for attached to the side of vehicle comprising a panel 10 having a top layer 12 and a bottom layer 14, wherein the bottom layer is made of a rubber magnetized sheet. (See column 2, lines 64-67).

Since the applicant does not disclose that die cutting solves any stated problem or is for any particular purpose, it appears that cutting or forming the shape of the sign using any suitable means would perform equally well.

It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the magnetic ornament taught by Cockerham made of a flexible rubber magnetized sheet as taught by Buhler to provide a light weight material and a material which can be rolled or otherwise deformed when not in use.

Claims 9, 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cockerham in view of Podoloff, U. S. Patent 3,245,165. Podoloff teaches a sign comprising a sign plate 20 having an upper face and a lower face. Podoloff also teaches a plurality of magnetic/suction cups for removably mounting the sign plate to a vehicle. (See figure 4 and column 4, lines 3-14). It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the ornament taught by Cockerham with magnetic/suction cups as taught by Podoloff to provide a means to removably attach the ornament to both metallic and non-metallic surface.

Allowable Subject Matter

4. Claims 6, 7, 8, 10, 11, and 19 are allowed.

Response to Arguments

5. Applicant's arguments filed January 19, 2005 have been fully considered but they are not persuasive.

With respect to claim 9, the applicant argues that there is nothing in the teaching of Cockerham or any other cited reference to suggest indicia representing a bent human forearm with the lower edge of the bent arm indicia spaced from the lower edge of planar member. The applicant also suggest that the proper test for obviousness is whether or not the claimed invention is shown or suggested by the prior art. The contends that Cockerham clearly shows shading to suggest depth or a three dimensional effect. As stated above, the examiner maintains, it would have been obvious to one having ordinary skill in the art at the time this invention was made to provide whatever indicia desired by the user (whether it be shading type indicia to give a three or two dimensional effect), since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In re Gulack 217 USPQ 401, (CAFC 1983). Mere support by the substrate for the printed matter in not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.


6. Applicant's arguments with respect to claim 12 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cassandra Davis whose telephone number is 703-308-2223. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 703-308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cassandra Davis
Primary Examiner
Art Unit 3611

CD
April 17, 2005